

REMARKS

This application has been carefully reviewed in view of the above Office Action. Reconsideration is respectfully requested in view of the following.

The undersigned wishes to bring to the Examiner's attention the fact that he is aware of three additional related applications pending which may be of interest to the Examiner during the examination of this application. Those applications have a general relationship to targeted advertisement and are identified below. The undersigned respectfully requests that the Examiner coordinate with the Examiners assigned to these applications and assure that the searches conducted are shared among the respective Examiners to assure that the best art available is brought forward in each case. The undersigned does not currently believe that the claims of these cases are similar enough to require that the Office Actions from each application be cross cited in each case, but nevertheless, in the interest of full disclosure, wishes for the Examiners to be made aware of the related subject matter and potential for overlap of relevant search material. The other applications of interest are:

Serial No. 09/752,632 filed 1/2/2001;
Serial No. 09/798,838 filed 3/2/2001; and
Serial No. 09/798,821 filed 3/2/2001.

This invention, in certain embodiments relates to targeted advertising. When locally stored content is played, a service provider is notified and the service provider sends an advertisement that is merged with the content. The merging of the content occurs at a user site that is remote from the service provider - e.g. at a television set-top box.

Regarding claim 1, this claim has been amended to explicitly call out that "*the stored entertainment content is stored at a content storage device at a user site that is remotely situated from the service provider*". While Srinivasan indeed appears to disclose a system in which targeted advertisements are inserted into entertainment content, there is no notification of the service provider of playback of locally stored entertainment content.

Rather, there is an ordering of remotely stored content which is then downloaded to the user. If the content is played back at a later time, Applicants find no suggestion that there is an additional notification sent to the service provider. Additionally, in the variation disclosed in column 32, lines 22-40, the advertisement is not received from the service provider, but is instead retrieved from the Internet based upon an embedded URL from the service provider.

In contrast, claim 1 requires that the initiation of a playback of locally stored content by the user be communicated to the service provider in order to initiate receipt of advertising content and merging of advertising with the entertainment content. Moreover, it is now clear that such merging will take place at the user site. There is no teaching or suggestion that such is the case or is possible in any way in Srinivasan.

The Office Action subsequently relies on the Garfinkle VOD system (e.g., in regards to claim 8) to illustrate that content is downloaded from a service provider to a local storage device. This is certainly possible even within the context of Applicant's invention. However, the undersigned finds no teaching or suggestion of the interaction between the service provider site and the user site needed to effect a merging of the advertising content with the entertainment content at the user site upon initiation of playback as called for by amended claim 1. Moreover, Applicant finds no teaching or suggestion of the hardware, software or other functionality needed at a user site device that could effect the functions of sending a notification of the initiation of entertainment content playback and the merging of subsequently received advertisement content.

In view of the above discussion, it is clear that the Srinivasan reference falls short of the disclosure needed to anticipate or obviate any of claims 1-9 as amended. Accordingly, reconsideration and allowance is respectfully requested.

Regarding independent claim 10 and dependent claims 11-26, claim 10 has been amended in a manner similar to that of claim 1. Accordingly, each of the above arguments favoring patentability are equally applicable. Claim 16 has been cancelled. Reconsideration of claims 11-15 and 17-26 is respectfully requested.

Regarding independent claim 27 and dependent claims 28-35, claim 27 has been amended in a manner similar to that of claim 1. Accordingly, each of the above arguments favoring patentability are equally applicable. Reconsideration of claims 27-35 is respectfully requested.

Regarding independent claim 36 and dependent claims 37-52, claim 36 has been amended in a manner similar to that of claim 1. Accordingly, each of the above arguments favoring patentability are equally applicable. Claim 37 has been cancelled. Reconsideration of claims 36 and 38-52 is respectfully requested.

Regarding independent claim 53 and dependent claims 54-58, claim 53 has been amended in a manner similar to that of claim 1. Accordingly, each of the above arguments favoring patentability are equally applicable. Reconsideration of claims 53-58 is respectfully requested.

Regarding independent claim 59 and dependent claims 60-70, claim 59 has been amended in a manner similar to that of claim 1. Accordingly, each of the above arguments favoring patentability are equally applicable. Reconsideration of claims 59-70 is respectfully requested.

Regarding independent claim 71 and dependent claims 72-81, claim 71 has been amended in a manner similar to that of claim 1. Accordingly, each of the above arguments favoring patentability are equally applicable. Reconsideration of claims 71-81 is respectfully requested.

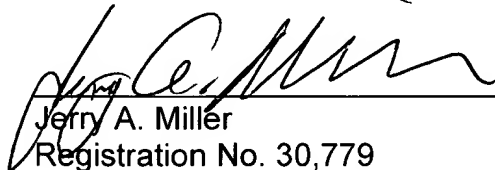
It is noted that claim 8, among others, as originally filed contains features similar to those of the amended independent claims in that the entertainment content is clearly stored in the set-top box which is remote from a service provider. Accordingly, it is believed that the present amendment cannot necessitate any new grounds of rejection that

can properly be deemed final, since this feature was present at filing and was not properly considered in making the current rejection.

The undersigned additionally notes that many other distinctions exist between the cited references and the invention as claimed. However, in view of the amendments and the clear deficiencies in the art as pointed out above, further discussion of these deficiencies is believed to be unnecessary at this time; failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position.

No amendment made was for the purpose of narrowing the scope of any claim unless an argument has been made herein that such amendment has been made to distinguish over a particular reference or combination of references. In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date.

Respectfully submitted,


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